



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,097	05/08/2002	Fridolin Storchli	P/154-44	7516

2352 7590 09/30/2003

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

BRAHAN, THOMAS J

ART UNIT PAPER NUMBER

3652

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary	Application No. 10/069,097	Applicant(s) STORCHLI ET AL.	
	Examiner Thomas J. Brahan	Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-69 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 35-69 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 35-69 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 and 7</u> . | 6) <input type="checkbox"/> Other: |

1. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

- I. Claims 35-55, drawn to a storage facility, classified in Class 414, subclass 262.
- II. Claims 56-69, drawn to a methods of storing items, classified in Class 414, subclass 800.

3. The inventions are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this application, the apparatus can be used with different processes, such as without the operating steps proceeding in part simultaneously, as recited in claim 56. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. This application also appears to contain claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The species are as follows:

- Species I shown in figures 2 and 3;
- Species II shown in figure 4; and
- Species III shown in figure 8.

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, as the species lack the same or corresponding special technical features. All of the species do not include separate input stations and delivery stations, and all of the species do not include stationary means for rotating the articles in the storage system.

6. Applicant is required, in reply to this action, to elect a invention and a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected invention and species. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species, see MPEP § 809.02(a). Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

7. To expedite prosecution, an action on the merits follows.

8. The disclosure is objected to because of the following informalities. Appropriate correction is required.

- a. The disclosure should be reviewed for translation errors. For example the term "tree" is used throughout the application for the term "three". As about half the sentences have grammar errors, as substitute specification is suggested.
- b. Page 11, line 13 of the specification refers to a wall 10 of the house. However drawing figure 6 uses the reference numeral 10 twice, as to indicate a different element in the drawing figure.
- c. Page 11, lines 19-22, refers to stationary displacement means 12 and to additional driven stationary displacement means 12.

9. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the structure of the displacement means 12, and the transfer means for the direct transfer of an article from one shelf serving apparatus to the other shelf serving apparatus of claims 48 and 62 must be shown, or the features must be canceled from the claims. No new matter may be entered.

10. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate description of the claimed invention.

- a. The structure of the displacement means 12 is not understood. Page 24, line 24 of the specification has that the "displacement means 12 can be formed for instance by a system of rollers or conveyor strips, of chain conveyors, a rail system or similar". However they are shown in the embodiment of figure 2 as four elements located adjacent input station 4. They are shown in the embodiment of figure 4 located close to, but not directly adjacent the input stations 3 and 4, and the embodiment of figure 8 has three sets of displacement means 12 at various parts of the parking facility. How can the disclosed roller system, conveyor strips, chain conveyors, or rail systems occupy only these scattered locations in the parking facility? Page 11, lines 19-22, refers to stationary displacement means and to additional driven stationary displacement means. How can some of these be considered as stationary and other be considered as driven?
- b. The structure of claims 48 and 62 which has transfer means for direct transfer of an article from one shelf serving apparatus to another is not understood. Where is it shown in the drawings or discussed in the specification? How does this transfer happen while the shelf serving apparatus is moving as recited in claims 51 and 63?

12. Claims 35-53 and 56-69 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

13. The following is a quotation of the second paragraph of 35 U.S.C. § 112:


The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention.

14. Claims 35-53, and 56-68 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example:

- a. In claim 35, line 3, the term "usable alternatively once" is not understood.
- b. In claim 35, line 4, the term "the other time" appears to be inaccurate.
- c. In claim 35, lines 5 and 6, the use of the term "parallel" is wrong.
- d. In claim 40 it is unclear as to what "it" refers to, and it is unclear as to what the entire claim is attempting to recite.
- e. In claims 42 and 43, it is unclear as to how foreseeing a structure positively recites the structure of the displacement means.
- f. In claim 43, it is unclear as to how the displacement means transfers items to the depot system, as the depot system is the entire parking facility, and the articles are appear to be already in the parking facility when handled by the stationary displacement means 12.
- g. Claim 44 is not understood. How is the applicant considering the transfer from a loading station, an input station or a delivery station to the displacement means (12) as occurring at the same vertical level as the transfer from the loading station, the input station or the delivery station and a user. Which embodiment has all of these stations? Only the embodiment of figure 8 has loading stations, and it does not delivery stations. How can claim 44 depend form claim 35 which has contradictory language with the two cells at the input stations.
- h. In claim 45, how can a direction coincide with one direction and be orientated transverse thereto as recited by using the term "and/or" in line 3?

- i. Claim 49 is awkward and is not fully understood. How can the shelf serving apparatuses have plural receiving places, as recited at the beginning of the claim, if the end of the claim recites that the second shelf serving apparatus has only one receiving place. Are the first two lines attempting to recite that each shelf serving apparatus has plural receiving places, or that the two shelf serving apparatuses taken together have plural receiving places? Claim 61 has a similar confusing contradiction.
 - j. In claim 56, it is unclear as to how the applicant is using the term "kind" in line 5. Either the device has a work dividing operation or not. It is also unclear as to how the limitation "proceeds in part simultaneously" is being used to describe the operating steps to delivery one single article. How can two devices move one element simultaneously?
 - k. It is unclear as to how claims 57 and 58 can properly depend from claim 56, as claim 56 is drawn to a method for a depot, and claims 57 and 58 are drawn to a method for a storage house. Is there a reason for this difference? Is applicant considering a storage house as different from a depot? What is this difference?
 - l. Claims 57-59 also recite the divided "kind" of operation and the "in part simultaneous" operations for delivering a single article which are not understood.
15. Due to their indefinite nature, claims 35-53 and 56-68 have not been further treated on the merits.
16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:
- A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
17. Claims 54, 55, and 69 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schween shows a parking garage with stationary means (80) for rotating articles about a vertical axis.
18. Bogar, Bryant, Rougemont, Shahar et al, and Givati are cited as showing related parking garage structures.

19. An inquiry concerning this action should be directed to Examiner Thomas J. Brahan at telephone number (703) 308-2568 on Mondays through Fridays from 9:30-7:00 EST. The examiner's supervisor, Ms. Eileen Lillis, can be reached at (703) 308-3248. The fax number for Technology Center 3600 is (703) 305-7687.

 9/14/03
THOMAS J. BRAHAN
PRIMARY EXAMINER